UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,288	10/20/2000	Dean F. Jerding	A-6686	8077

5642 7590 07/15/2004

SCIENTIFIC-ATLANTA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
5030 SUGARLOAF PARKWAY
LAWRENCEVILLE, GA 30044

EXAMINER	
BELIVEAU, SCOTT E	

ART UNIT	PAPER NUMBER
2614	12

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/693,288	Applicant(s) JERDING ET AL.	
	Examiner Scott Beliveau	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 June 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *41-58 and 71-83* is/are pending in the application.

4a) Of the above claim(s) *76-82* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *41-58,71-75 and 83* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 February 2004* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claim 40-58 and 71-83 have been considered but are moot in view of the new ground(s) of rejection.

Election/Restrictions

2. Newly submitted claims 76-82 are directed to an invention that is independent or distinct from the invention originally claimed. In particular, the originally claimed invention was directed towards the extension of a rental of a VOD presentation. Newly presented claim 76 is solely directed towards determining and alerting a user the remaining playing time of a presentation is less than the rental period. While the originally elected claims provided an alert to the user during the presentation of the movie (Figure 12), the newly presented claims are directed towards the determination and the display of the remaining time in the rental period in conjunction with the user stopping the presentation (Figure 11).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 76-82 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Priority

3. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 41-58, 71-75, and 83 of this application. While the provisional application discloses the general concept of facilitating the extension of a rental, the examiner cannot find support for the claimed limitations for "providing by the STT the user with a selectable option during the first access duration, the selectable option being configured to enable the user to access the movie during a second access duration that is later in time than the first access duration" or limitations pertaining to "indicating a remaining portion of the first access duration and a remaining playing time of the movie". In particular, the cited limitation is not particularly be related to the extension of a rental. Rather, it could simply refer to re-renting of a video presentation at a later date. Furthermore, there is inadequate support such that a rental extension is necessarily occurring during the first period as the only reference to a rental extension is in conjunction with the "Rental Period Expiring screen" (Page 7 – Ease of Use).

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations of claims 73 and 75 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should

include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 73 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, it is the examiner's understanding that the interruption of the movie responsive to "a user input" does not

require a subsequent "user input" so as to "cause the STT to provide the selectable option". Rather as illustrated in Figures 7, 10, and 11, the "selectable option" [123] is displayed as a direct result of the initial user input, as opposed to requiring a subsequent input.

7. Claim 75 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, it is unclear as to how the "first and second access duration" in connection with the illustrated embodiments may be "non-contiguous" given that the disclosed embodiment is directed towards the extension of a rental duration.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 41, 45, 46, 47, 49, 50, 51, 55, 56, 57, and 71-74 are rejected under 35 U.S.C. 102(b) as being anticipated by LaJoie et al. (US Pat No. 5,632,681).

Claim 41 is rejected wherein Figure 1 of LaJoie et al. illustrates a "method" for providing "video content to a user via a television set-top terminal ("STT") [6] that is "coupled to a television" (Col 9, Lines 38-62). The method involves "receiving by

the STT user input corresponding to a movie" associated with an IPPV channel whereupon a "first access duration" or free-preview is "assigned" such that the "STT" [6] is "enabled to . . . access the movie during the first access duration". "During the first access duration", the "STT" [6] "provides . . . a selectable option" [552] that is "configured to enable the user to access the movie during a second access duration that is later in time than the first access duration" [602]. The "STT" [6] subsequently, "receives . . a user input corresponding to the selectable option" [252] such that the "STT" [6] is operable to "access", "receive" from a "server located remotely from the STT" [16], and "output. . . to the television" "at least a portion of the movie" "during the second access duration" corresponding to the remainder of the movie (Figure 32; Col 32, Lines 22-43).

Claim 51 is rejected in view of claim 41 wherein the "STT" [6], as illustrated in Figure 3, comprises "at least one memory having stored thereon program code" [32] and "at least one processor that is programmed by at least the program code" [30] (Col 13, Lines 6-65).

Claims 45 and 55 are rejected wherein the "selectable option is provided during an interruption in outputting the movie by the STT" as shown in Figure 32 wherein any time before the "first access period" or preview is over, an interruption initiated by the user causes the display of the purchase window with associated selectable option to purchase the remainder of the movie.

Claims 46 and 56 are rejected wherein "prior to the step of receiving the user input corresponding to the selectable option" the user is "provided with information indicating that there is insufficient time remaining in the first access duration to

enable the user to view a remainder of the movie" wherein the information discloses that the "first duration" or free preview lasting 15 minutes is insufficient time to watch the entire movie lasting ~2 hours (Figure 30).

Claims 47 and 57 are rejected in view of Figure 32 which illustrates "prior to the step of receiving the user input corresponding to the selectable option, providing the user with information indicating an amount of time remaining the first access period" or 15 minutes.

Claim 49 is rejected wherein the user is "provided with pricing information related to the second access duration". For example, the price is $3.95 to order the movie in its entirety (Figure 32).

Claim 50 is rejected wherein the user is "charged . . . a first price in connection with the first access duration" of zero dollars and a "second price in connection with the second access duration" of $3.95.

Claim 71 is rejected wherein the "interruption is implemented by the STT responsive to user input" [606].

Claim 72 is rejected wherein the "selectable option is provided substantially immediately after the interruption is implemented by the STT" as illustrated in Figure 32.

Claim 73 is rejected wherein as illustrated in Figure 32, the method further comprises "interrupting outputting the movie by the STT responsive to receiving a user input configured to cause the STT to interrupt the movie" so as to display the attention barker [552]. The user may subsequently, submit another user input so as to cancel the action thereby resuming the output of the movie [604]. Accordingly, "after

receiving the user input configured to cause the STT to interrupt the movie", the method involves "receiving a user input" or "B" key to once again "cause the STT to provide the selectable option, wherein the selectable option is provided responsive to receiving the user input configured to cause the STT to provide the selectable option" [552]. "After providing the selectable option", the "STT" [6] is operable to "resume outputting the movie, either in conjunction with further canceling the purchase or actually purchasing the presentation.

Claim 74 is rejected wherein the "first and second access durations are contiguous" such that the end of the free preview marks the start of the duration of the paid presentation of the movie.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order

for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 42-44, 52-54, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaJoie et al. (US Pat No. 5,632,681), in view of Lett et al. (US Pat No. 5,592,551).

In consideration of claims 42 and 52, LaJoie et al. discloses that the particular movie may be a form of "video-on-demand movie", however the reference does not particularly disclose nor preclude that the free preview duration is "greater than or equal to a total uninterrupted play time of the movie". The reference is not limited as to the particular duration of the "first access period". It is commonly known in the art for parents to preview a movie in its entirety prior to their children watching the movie so as to ensure that the movie does not comprise inappropriate material. Furthermore, it is known in the art for individuals to order multiple showings of the same presentation. The Lett et al. reference discloses a method for ordering multiple showings of the same presentation including both a present and future showing of a "video-on-demand movie" (Figures 13-16; Col 16, Lines 38-55). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to establish a "first access duration" or free preview that is "greater than or equal to a total uninterrupted play time of the movie" for the purpose of encouraging program rentals by providing a means to allow a parent to watch a free preview showing of a questionable movie and on the basis of a no-cost review of the entire presentation may subsequently order a paid copy for their children for a later time.

In consideration of claims 43, 44, 53, and 54, Figure 32 of the LaJoie et al. reference the selectable options presented during the first access duration, does not explicitly disclose nor preclude the further display of additional selectable options. The Lett et al. reference discloses an IPPV ordering system wherein the user is "provided with a plurality of selectable options . . . having a corresponding access duration that is later in time than the first access duration and being configured to enable the user to access the movie during the corresponding access duration" wherein each of the selectable options corresponds to respective "information identifying a plurality of prices" (Figures 13-16; Col 16, Lines 38-55). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to provide the user with a "plurality of selectable options" in conjunction with the purchase routine as illustrated in Lett et al. for the purpose of advantageously providing the user with additional flexibility in ordering programming. For example, a user that watches a free preview of an event may not have the time at that moment to watch the entire presentation. Accordingly, the combined teachings provide a means by which the user may purchase/schedule a future showing.

Claim 75 is rejected wherein the "first and second access durations are non-contiguous" such that the user may subsequently purchase a subsequent showing at a later date.

13. Claims 48 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaJoie et al. (US Pat No. 5,632,681), in view of White et al. (US Pat No. 6,628,302)..

In consideration of claims 48 and 58, the LaJoie et al. reference, while disclosing the total amount of playing time of a presentation, as well as the amount of time associated with the "first access duration", does not explicitly further disclose that the user is further provided with "information indicating an amount of playing time corresponding to a remainder of the movie". Furthermore, the "first access duration" of LaJoie et al. is disclosed as being limited to IPPV implementations. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further utilize the free-preview period in conjunction with other video distribution methods disclosed by LaJoie et al. including VOD for the purpose of encouraging/enticing users to order VOD programming.

The White et al. reference discloses a method for controlling a VOD presentation that "provides the user with information indicating an amount of playing time corresponding to a remainder of the movie, the remainder being calculated from a current interruption point in the movie" (Figure 5; Col 5, Lines 16-32; Col 6, Lines 2-9). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to present additional information "indicating a remaining portion of the first access duration and a remaining playing time of the movie" for the purpose of providing the user with an indication of the place in the movie that they have stopped versus the remaining time left in the free-rental period.

14. Claim 83 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goode et al. (US Pat No. 6,166,730), in view of White et al. (US Pat No. 6,628,302).

In consideration of claim 41, the Goode et al. reference discloses a method for providing "video content to a user via a television" as illustrated in conjunction with

Figure 1. The method involves "receiving by the STT a first user input corresponding to a movie" whereupon a "first access duration" associated with the rental terms are selected "responsive to receiving the first user input" (Col 14, Lines 11-25; Col 14 Line 55 – Col 15, Line 22). A user is subsequently "enabled . . . to access" and "output . . . at least a portion of the movie to the television" during the "first access duration" by "receiving during the first access duration at least a portion of the movie from a server remotely located from the STT" [102] (Figure 7). During the presentation of the movie the "STT" [118], is operable to "receive . . . a second user input during the first access duration" in conjunction with the VOD controls (Col 5, Lines 31-47). The Goode reference does not particularly disclose nor preclude the display of "information" in association the control functions, however, such information is available to the system (Figure 6).

The White et al. reference discloses a method for controlling a VOD presentation wherein "responsive to receiving the second user input outputting to the television information indicating . . . a remaining playing time of the movie, wherein the information is output by the STT in conjunction with a portion of the movie" (Figure 5; Col 5, Lines 16-32; Col 6, Lines 2-9). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to present additional information "indicating a remaining portion of the first access duration and a remaining playing time of the movie" for the purpose of providing the user with an indication of the place in the movie that they have stopped versus the remaining time left in the rental period.

For example, the Goode et al. reference discloses that the embodiment is operable to determine if there is insufficient rental time remaining for viewing a remainder of the media rental such that the presentation will not be terminated until the user terminates the presentation or the movie concludes (Col 16, Lines 42-59). Accordingly, a user who temporarily or mistakenly leaves a movie presentation in progress whose "access duration" has expired would unexpectedly be unable to return to the movie as it would no longer be available as an active media presentation. Accordingly, the display of the aforementioned information would serve the inform the user that they will have to reorder the presentation should they exit the presentation thereby advantageously reducing the number of dissatisfied customers and number of account credits.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Tsukamoto et al. (US Pat No. 5,796,828) reference discloses a method and apparatus for transferring limited reproduction rights to broadcast data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-

4907. The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB
July 1, 2004

JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600